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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 10/718,362  
Filing Date: November 20, 2003  
Appellant(s): CAPORALI, MICHAEL E.

DEC 13 2007

**GROUP 3600**

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Melissa A. Beede  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11-2-2007 appealing from the Office action  
mailed 6-20-2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

1,659,509	Ashbrook	2-1928
3,754,646	Henig	8-1973

3,908,821	Lambert	9-1975
6,715,614	Pippin	4-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4-10 and 12- 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashbrook, in view of US 6,715,614 to Pippin et al. Ashbrook discloses a bottom defining a substantially planar surface having a length and a width (Fig. 1), wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the standard mail sorting bin; and at least one support (9) projecting upright from the bottom, wherein the support is sized and configured to support flat mail in a substantially vertical orientation. Ashbrook fails to disclose each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin. Pippin discloses each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin (figure 2 and 4) for the purpose of maintaining sequence order and facilitating delivery (c8 lines 52+). Pippin also discloses dimensioning the insert such that it fits closely within letter trays used by the USPS (c6 lines 13+) for the purpose of allowing storage and use of the insert with flats tubs or letter trays (c6 lines 10+). Examiner further contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Ashbrook device is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to have modified Ashbrook to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

With regards to claim 2, Ashbrook further discloses the insert comprises a lightweight material (page 1, lines 20+).

With regards to claim 4, Ashbrook further discloses the insert comprises two supports (Fig. 1).

With regards to claim 5, Ashbrook further discloses the bottom of the insert comprises three substantially coplanar sections which are separated from each other by the two supports, and wherein the two supports have substantially triangular-shaped cross sections (Fig. 1).

With regards to claim 6, Ashbrook further discloses the at least one support has a triangular-shaped cross section (Fig. 1).

With regards to claim 7, Ashbrook further discloses the bottom and at least one support are created from a single piece of material (5).

With regards to claim 8, Ashbrook further discloses the at least one support is created by folding the single piece of material (page 1, lines 20+).

With regards to claim 9, Ashbrook further discloses at least one substantially rigid, substantially vertical section projecting from a substantially horizontal section,

wherein the insert is sized and configured to receive flat mail from an automatic mail sorter (Fig. 1). Ashbrook does not disclose each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin. Pippin discloses each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin (c6 lines 10+) for the purpose of storing and using the insert with flats tubs or letter trays (c6 lines 10+). Examiner contends that the Pippin insert will inherently be of the claimed size in order to fit closely with existing letter trays used by the USPS (c6 lines 14+). Examiner further contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Ashbrook device is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ashbrook to include each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

With regards to claim 10, Ashbrook further discloses the insert comprises a lightweight material (page 1, lines 20+).

With regards to claim 12, Ashbrook further discloses the insert has two substantially vertical sections (Fig. 1).

With regards to claim 13, Ashbrook further discloses the at least one substantially vertical section has a substantially triangular-shaped cross section (Fig. 1).

With regards to claim 15, Ashbrook further discloses the insert comprises a single piece of material (page 1, lines 20+).

With regards to claim 16, Ashbrook further discloses the insert is folded to create the substantially vertical sections and substantially horizontal sections (page 1, lines 20+).

With regards to claim 17, Pippin discloses the height of each substantially vertical section approximates a height of a mail sorting bin (fig 4) for the purpose of maintaining sequence order and facilitating delivery (c8 lines 52+).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ashbrook to include the height of each substantially vertical section approximates a height of a mail sorting bin, as taught by Pippin, for the purpose of maintaining sequence order and facilitating delivery.

With regards to claim 18, Ashbrook further discloses the insert comprises an anti-slip surface (page 1, lines 20+). What constitutes an anti-slip surface? The disclosed surface has some degree of friction and so has, to some extent, an anti-slip surface.

With regards to claim 19, Ashbrook further discloses a base defining a substantially planar surface, wherein the base is sized to substantially cover a bottom surface of a mail sorting bin; and a plurality of substantially vertical supports attached to the base, wherein each substantially vertical support has a slope height and a triangular-shaped cross section sized and configured to support flat mail in a substantially vertical orientation (Fig. 1). Ashbrook fails to disclose each support is constructed such that a maximum height of the support approximates a maximum

height of the mail sorting bin. Pippin discloses each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin (figure 2 and 4) for the purpose of maintaining sequence order and facilitating delivery (c8 lines 52+). Pippin also discloses dimensioning the insert such that it fits closely within letter trays used by the USPS (c6 lines 13+) for the purpose of allowing storage and use of the insert with flats tubs or letter trays (c6 lines 10+). Examiner further contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Ashbrook device is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ashbrook to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

With regards to claim 20, Ashbrook further discloses a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines, wherein two adjacent sections are separated by a predefined fold line, and wherein the predefined fold lines are arranged and configured such that when the flat sheet is folded at the predefined fold lines, the sheet forms a base and at least one upright support sized and configured to support flat mail in an upright orientation (Fig. 1; page 1, lines 20+)

Ashbrook does not disclose the support having a height of approximately 11 inches.

Pippin discloses the support having a height of approximately 11 inches (c6 lines 11+) for the purpose of fitting closely within existing letter trays use by the USPS (c6 lines 13+). Examiner contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Ashbrook device is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ashbrook to include the support having a height of approximately 11 inches, as taught by Pippin, for the purpose of fitting closely within existing letter trays use by the USPS.

With regards to claim 21, Ashbrook further discloses the flat sheet has an upper surface and a lower surface, and wherein at least one predefined fold line on the upper surface permits a first section to rotate with respect to an adjacent second section in one direction, and wherein at least one predefined fold on the lower surface line permits a third section to rotate with respect to an adjacent fourth section in the other direction (Fig. 1; page 1, lines 20+).

With regards to claim 22-27 Pippin discloses each of the substantially vertical support of the at least one substantially vertical support has a height of approximately 11 inches and the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep (c6 lines 10+) for the purpose of storing and using the insert with flats tubs or letter trays (c6 lines 10+). Examiner contends that the Pippin insert and bin will

inherently be of the claimed size in order to fit closely with existing letter trays used by the USPS (c6 lines 14+).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ashbrook to include each of the substantially vertical support of the at least one substantially vertical support has a height of approximately 11 inches and the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Claims 1-13 and 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lambert in view of Pippin. Lambert discloses a bottom defining a substantially planar surface (35) having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of a mail sorting bin; and at least one support (13) projecting upright from the bottom, wherein the support is sized and configured to support flat mail in a substantially vertical orientation. Lambert fails to disclose each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin. Pippin discloses each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin (figure 2 and 4) for the purpose of maintaining sequence order and facilitating delivery (c8 lines 52+). Examiner contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Lambert insert is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Lambert to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery.

With regards to claim 2, Lambert further discloses the insert comprises a lightweight material (col. 3, lines 14+).

With regards to claim 3, Lambert further discloses the insert comprises a material selected from the group consisting of cardboard, plastic, wood, and composites (col. 3, lines 14+).

With regards to claim 4, Lambert further discloses the insert comprises two supports (Fig. 2).

With regards to claim 5, Lambert further discloses the bottom of the insert comprises three substantially coplanar sections which are separated from each other by the two supports, and wherein the two supports have substantially triangular-shaped cross sections (Fig. 2).

With regards to claim 6, Lambert further discloses the at least one support has a triangular-shaped cross section (Fig. 2).

With regards to claim 7, Lambert further discloses the bottom and at least one support are created from a single piece of material (col. 3, lines 14+).

With regards to claim 8, Lambert further discloses the at least one support is created by folding the single piece of material (col. 3, lines 14+).

With regards to claim 9, Lambert further discloses at least one substantially rigid substantially vertical section projecting from a substantially horizontal section, wherein the insert is sized and configured to receive flat mail from an automatic mail sorter (Fig. 2). Lambert does not disclose each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin. Pippin discloses each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin (c6 lines 10+) for the purpose of storing and using the insert with flats tubs or letter trays (c6 lines 10+). Examiner contends that the Pippin insert will inherently be of the claimed size in order to fit closely with existing letter trays used by the USPS (c6 lines 14+). Examiner further contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Lambert insert is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Lambert to include each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

With regards to claim 10, Lambert further discloses the insert comprises a lightweight material (col. 3, lines 14+).

With regards to claim 11, Lambert further discloses the lightweight material is selected from the group consisting of cardboard, plastic, wood, and composites (col. 3, lines 14+).

With regards to claim 12, Lambert further discloses the insert has two substantially vertical sections (Fig. 2).

With regards to claim 13, Lambert further discloses the at least one substantially vertical section has a substantially triangular-shaped cross section (Fig. 2).

With regards to claim 15, Lambert further discloses the insert comprises a single piece of material (col. 3, lines 14+).

With regards to claim 16, Lambert further discloses the insert is folded to create the substantially vertical sections and substantially horizontal sections (col. 3, lines 14+).

With regards to claim 17, Pippin discloses the height of each substantially vertical section approximates a height of a mail sorting bin (fig 4) for the purpose of maintaining sequence order and facilitating delivery (c8 lines 52+).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Lambert to include the height of each substantially vertical section approximates a height of a mail sorting bin, as taught by Pippin, for the purpose of maintaining sequence order and facilitating delivery.

With regards to claim 18, Lambert further discloses the insert comprises an anti-slip surface (col. 3, lines 14+). What constitutes an anti-slip surface? The disclosed surface has some degree of friction and so has, to some extent, an anti-slip surface.

With regards to claim 19, Lambert further discloses a base defining a substantially planar surface, wherein the base is sized to substantially cover a bottom surface of a mail sorting bin as defined by the postal service and a plurality of

substantially vertical supports attached to the base, wherein each substantially vertical support has a slope height and a triangular-shaped cross section sized and configured to support flat mail in a substantially vertical orientation (Fig. 2). Lambert fails to disclose each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin. Pippin discloses each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin (figure 2 and 4) for the purpose of maintaining sequence order and facilitating delivery (c8 lines 52+). Pippin also discloses dimensioning the insert such that it fits closely within letter trays used by the USPS (c6 lines 13+) for the purpose of allowing storage and use of the insert with flats tubs or letter trays (c6 lines 10+). Examiner further contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Lambert insert is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Lambert to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

With regards to claim 20, the reference further discloses a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines, wherein

two adjacent sections are separated by a predefined fold line, and wherein the predefined fold lines are arranged and configured such that when the flat sheet is folded at the predefined fold lines, the sheet forms a base and at least one upright support sized and configured to support flat mail in an upright orientation, (col. 3, lines 14+). Lambert does not disclose the support having a height of approximately 11 inches. Pippin discloses the support having a height of approximately 11 inches (c6 lines 11+) for the purpose of fitting closely within existing letter trays use by the USPS (c6 lines 13+). Examiner contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Lambert insert is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Lambert to include the support having a height of approximately 11 inches, as taught by Pippin, for the purpose of fitting closely within existing letter trays use by the USPS.

With regards to claim 21, the reference further discloses the flat sheet has an upper surface and a lower surface, and wherein at least one predefined fold line on the upper surface permits a first section to rotate with respect to an adjacent second section in one direction, and wherein at least one predefined fold line on the lower surface permits a third section to rotate with respect to an adjacent fourth section in the other direction (col. 3, lines 14+).

With regards to claim 22-27 Pippin discloses each of the substantially vertical support of the at least one substantially vertical support has a height of approximately

11 inches and the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep (c6 lines 10+) for the purpose of storing and using the insert with flats tubs or letter trays (c6 lines 10+). Examiner contends that the Pippin insert and bin will inherently be of the claimed size in order to fit closely with existing letter trays used by the USPS (c6 lines 14+).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Lambert to include each of the substantially vertical support of the at least one substantially vertical support has a height of approximately 11 inches and the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Claims 1-13 and 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henig in view of Pippin. Henig discloses a bottom (2a) defining a substantially planar surface having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of a standard mail bin as defined by the postal service; and at least one support (7a, 3) projecting upright from the bottom, wherein the support (3) is sized and configured to support flat mail in a substantially vertical orientation (Fig. 11). Henig fails to disclose each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin. Pippin discloses each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin (figure 2 and 4) for the purpose of maintaining sequence order and

facilitating delivery (c8 lines 52+). Examiner contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Henig device is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Henig to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery.

With regards to claim 2, Henig further discloses the insert comprises a lightweight material (col. 7, lines 10+).

With regards to claim 3, Henig further discloses the insert comprises a material selected from the group consisting of cardboard, plastic, wood, and composites (col. 7, lines 10+).

With regards to claim 4, Henig further discloses the insert comprises two supports (Fig. 11).

With regards to claim 5, Henig further discloses the bottom of the insert comprises three substantially coplanar sections which are separated from each other by the two supports, and wherein the two supports have substantially triangular-shaped cross sections (Fig. 11).

With regards to claim 6, Henig further discloses the at least one support has a triangular-shaped cross section (Fig. 11).

With regards to claim 7, Henig further discloses the bottom and at least one support are created from a single piece of material (col. 7, lines 10+).

With regards to claim 8, Henig further discloses the at least one support is created by folding the single piece of material (col. 7, lines 10+).

With regards to claim 9, the reference further discloses at least one substantially rigid substantially vertical section projecting from a substantially horizontal section, wherein the insert is sized and configured to receive flat mail from an automatic mail sorter (Fig. 11). Henig does not disclose each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin. Pippin discloses each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin (c6 lines 10+) for the purpose of storing and using the insert with flats tubs or letter trays (c6 lines 10+). Examiner contends that the Pippin insert will inherently be of the claimed size in order to fit closely with existing letter trays used by the USPS (c6 lines 14+). Examiner further contends that the language “constructed to be disposed within a mail sorting bin” is functional and the Henig insert is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Henig to include each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

With regards to claim 10, Henig further discloses the insert comprises a lightweight material (col. 7, lines 10+).

With regards to claim 11, Henig further discloses the lightweight material is selected from the group consisting of cardboard, plastic, wood, and composites (col. 7, lines 10+).

With regards to claim 12, Henig further discloses the insert has two substantially vertical sections (Fig. 11).

With regards to claim 13, Henig further discloses the at least one substantially vertical section has a substantially triangular-shaped cross section (Fig. 11).

With regards to claim 15, Henig further discloses the insert comprises a single piece of material (col. 7, lines 10+).

With regards to claim 16, Henig further discloses the insert is folded to create the substantially vertical sections and substantially horizontal sections (col. 7, lines 10+).

With regards to claim 17, Pippin discloses the height of each substantially vertical section approximates a height of a mail sorting bin (fig 4) for the purpose of maintaining sequence order and facilitating delivery (c8 lines 52+).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Henig to include the height of each substantially vertical section approximates a height of a mail sorting bin, as taught by Pippin, for the purpose of maintaining sequence order and facilitating delivery.

With regards to claim 18, Henig further discloses the insert comprises an anti-slip surface (col. 7, lines 10+). What constitutes an anti-slip surface? The disclosed surface has some degree of friction and so has, to some extent, an anti-slip surface.

With regards to claim 19, the reference further discloses a base defining a substantially planar surface, wherein the base is sized to substantially cover a bottom surface of a mail sorting bin as defined by the postal service; and a plurality of substantially vertical supports attached to the base, wherein each substantially vertical support has a slope height and a triangular-shaped cross section sized and configured to support flat mail in a substantially vertical orientation (Fig. 11). Henig fails to disclose each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin. Pippin discloses each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin (figure 2 and 4) for the purpose of maintaining sequence order and facilitating delivery (c8 lines 52+). Pippin also discloses dimensioning the insert such that it fits closely within letter trays used by the USPS (c6 lines 13+) for the purpose of allowing storage and use of the insert with flats tubs or letter trays (c6 lines 10+). Examiner further contends that the language “constructed to be disposed within a mail sorting bin” is functional and the Henig insert is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Henig to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail

sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

With regards to claim 20, Henig further discloses a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines, wherein two adjacent sections are separated by a predefined fold line, and wherein the predefined fold lines are arranged and configured such that when the flat sheet is folded at the predefined fold lines, the sheet forms a base and at least one upright support sized and configured to support flat mail in an upright orientation (col. 7, lines 10+). Henig does not disclose the support having a height of approximately 11 inches. Pippin discloses the support having a height of approximately 11 inches (c6 lines 11+) for the purpose of fitting closely within existing letter trays use by the USPS (c6 lines 13+). Examiner contends that the language "constructed to be disposed within a mail sorting bin" is functional and the Henig device is fully capable of being disposed within a mail sorting bin.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Henig to include the support having a height of approximately 11 inches, as taught by Pippin, for the purpose of fitting closely within existing letter trays use by the USPS.

With regards to claim 21, Henig further discloses the flat sheet has an upper surface and a lower surface, and wherein at least one predefined fold line on the upper

surface permits a first section to rotate with respect to an adjacent second section in one direction, and wherein at least one predefined fold on the lower surface line permits a third section to rotate with respect to an adjacent fourth section in the other direction (col. 7, lines 10+).

With regards to claim 22-27 Pippin discloses each of the substantially vertical support of the at least one substantially vertical support has a height of approximately 11 inches and the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep (c6 lines 10+) for the purpose of storing and using the insert with flats tubs or letter trays (c6 lines 10+). Examiner contends that the Pippin insert and bin will inherently be of the claimed size in order to fit closely with existing letter trays used by the USPS (c6 lines 14+).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Henig to include each of the substantially vertical support of the at least one substantially vertical support has a height of approximately 11 inches and the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

#### **(10) Response to Argument**

**A. Claims 1, 2, 4-10 12-13, and 15-27 are not patentable over Ashbrook in view of Pippin.**

The rejection of claims 1, 2, 4-10 12-13, and 15-27 as obvious over Ashbrook in view of Pippin is proper and should be affirmed.

i. Independent claim 1

Appellant stated, "*Applicants disagree that there is any acceptable suggestion or motivation in the prior art to modify the teachings of Ashbrook with the teachings of Pippin to achieve the claimed invention.*"

Examiner contends that the claim does not positively recite the mail bin in a way that actually requires the mail bin and therefore without the mail bin the size of features relative to the mail bin is functional. The Ashbrook device is capable of being placed in a bin that would have a size meeting the relative limitations set forth in the claim. The combination with Pippin shows that inserts, such as that disclosed by Ashbrook, can and are readily placed in mail bins and sized accordingly to the bins. Therefore Pippin is only necessary to show that an insert can be placed in a bin and sized according to the bin. The claim is drawn to a mail bin insert rather than the combination of mail bin insert and a mail bin in which the insert is disposed therefore Pippin is only needed to show the ability of an insert to be placed in a bin and sized accordingly not the actual mail bin or sizing of the insert. Beyond showing the mere capability of the placement in the bin and appropriate sizing relative thereto Examiner further contends that one of ordinary skill in the art would be motivated to combine the teachings for the purposes of maintaining sequence order and facilitating delivery (c6 lines 13+) and allowing storage and use of the insert with flats tubs or letter trays (c6 lines 10+).

1. The proposed Modification to Ashbrook Would Render the Invention Unsatisfactory for its Intended Purpose.

Regarding the combination of Ashbrook in view of Pippin the Appellant stated, "*would (1) render the envelope holder of Ashbrook unable to be disposed in a conventional desk drawer, and (2) prohibit envelopes held by the envelope holder from being readily grasped and removed, thwarting both the "principle use" and "aim" of the invention. Indeed, the envelope holder would lose all practical functionality as an envelope holder.*"

First Examiner takes note that is not actually necessary to place the insert in a bin or change it physically to meet the limitations of the claim. Pippin is only necessary to show the capability of the insert to be placed in a bin and sized accordingly as the limitations are functional and the claim does not actually require a bin. Secondly Examiner disagrees that if the insert was modified that it would be unable to be disposed in a conventional desk drawer as argued. Conventional desk drawers vary greatly in size and many are sized to accommodate hanging folders. Examiner contends that even if the modifications were made the device could still fit in at least some portion of conventional desks drawers such as those configured to hold hanging folders. Third Examiner contends that the modification would not prevent the envelopes from being readily grasped as each area for receiving envelopes would still be of a size that would allow such action. Furthermore some envelopes are larger than others and will always be easier to remove than other smaller envelopes.

Examiner further contends that the appellant has taken a narrow view of the actual function of the Ashbrook device. Examiner contends that the function is to hold

flat items in a relatively vertical position so they can be easily removed. Ashbrook even discloses the device "is not restricted to use within a drawer, nor to the holding of envelopes" (p1 lines 64+). Examiner contends that even if modified to actually be placed in a bin and sized accordingly the Ashbrook device will still readily perform its intended function.

2. The Proposed Modification to Ashbrook Would Change the Principle of Operation of the Invention.

Appellant stated, "*the Examiner suggests modifying Ashbrook so that the envelope holder is used for mail delivery, a purpose completely unrelated to - and incompatible with - its intended purpose.*" And "*the modification suggested by the Examiner requires the type of "substantial reconstruction and redesign" that the Ratti court deemed an improper modification of the primary reference.*" And "*The proposed modification entirely changes both the structure and purpose of the invention of Ashbrook. In particular, the proposed modification would result in an envelope holder that would no longer resemble the inventive structure envisioned in Ashbrook, and have none of the functionality originally intended.*"

Examiner disagrees with all of the above statements and maintains that no actual physical modification is necessary to meet the claimed limitations but rather that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly. Therefore it is not necessary to physically modify the Ashbrook device to meet claim limitations drawn to a mail bin insert without the bin.

Furthermore examiner contends that even if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Ashbrook device. The Ashbrook device would still be used to hold flat articles, in particular envelopes, in a substantially upright position such that they can easily be grasped and removed. Furthermore as set forth previously examiner contends that the device would still readily fit in many conventional desk drawers. The fact that the device is being used to facilitate mail delivery does not change that it is still holding envelopes in the manner in which it was designed. Mail delivery and sorting is a further application of the functionality and intended envelope holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still performing its originally designed function of holding envelopes in a vertical position where they can be easily grasped and removed. Further Examiner contends that these features would make the device especially useful and beneficial for use in mail sorting and delivery.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly. No physical modification is needed to meet the claimed limitations directed to a mail bin insert.

Appellant stated, "Accordingly, one would not have been motivated to combine Ashbrook with Pippin, because Pippin teaches away from a mail sorting structure

*having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort."*

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Ashbrook or the claimed invention. Both Ashbrook and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Ashbrook or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

ii. Independent Claim 9

1. The proposed Modification to Ashbrook Would Render the Invention  
Unsatisfactory for its Intended Purpose.

Appellant stated, "*Modifying the pockets 6 of the envelope holder of Ashbrook to have a height of approximately 11 inches would thus prohibit (1) envelopes from being readily grasped and removed, and (2) disposal of the envelope holder in conventional desk drawers. Accordingly, the proposed modification would render the envelope holder of Ashbrook unsatisfactory for its intended purpose, and thus there is no motivation to make such a modification.*"

First Examiner takes note that is not actually necessary to place the insert in a bin to meet the limitations of the claim. Pippin is only necessary to show the capability of the insert to be placed in a bin and sized accordingly as the limitations are functional and the claim does not actually require a bin. Secondly Examiner disagrees that if the insert was modified that it would be unable to be disposed in a conventional desk drawer as argued. Conventional desk drawers vary greatly in size and many are sized to accommodate hanging folders. Examiner contends that even if the modifications were made the device could still fit in at least some portion of conventional desks drawers such as those configured to hold hanging folders. Third Examiner contends that the modification would not prevent the envelopes from being readily grasped as each area for receiving envelopes would still be of a size that would allow such action.

Furthermore some envelopes are larger than others and will always be easier to remove than other smaller envelopes.

Examiner further contends that the appellant has taken a narrow view of the actual function of the Ashbrook device. Examiner contends that the function is to hold flat items in a relatively vertical position so they can be easily removed. Ashbrook even discloses the device "is not restricted to use within a drawer, nor to the holding of envelopes" (p1 lines 64+). Examiner contends that even if modified to actually be placed in a bin and sized accordingly the Ashbrook device will still readily perform its intended function.

2. The Proposed Modification to Ashbrook Would Change the Principle of Operation of the Invention.

Appellant stated, "*...the Examiner proposed using the envelope holder for mail delivery. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the envelope holder of Ashbrook, as well as a change in the basic principle (i.e., holding envelopes for personal or office use) under which the envelope holder was designed to operate.*"

Examiner disagrees with the above statement and maintains that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly.

Furthermore examiner contends that even if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Ashbrook device. The Ashbrook device would still be used to hold flat articles, in particular envelopes, in a substantially upright position such that they can easily be grasped and removed. Furthermore as set forth previously examiner contends that the device would still readily fit in many conventional desk drawers. The fact that the device is being used to facilitate mail delivery does not change that it is still holding envelopes in the manner in which it was designed. Mail delivery and sorting is a further application of the functionality and intended envelope holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still performing its originally designed function of holding envelopes in a vertical position where they can be easily grasped and removed. Further Examiner contends that these features would make the device especially useful and beneficial for use in mail sorting and delivery.

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Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly.

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*having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort."*

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Ashbrook or the claimed invention. Both Ashbrook and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Ashbrook or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

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Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

iii. Independent Claim 19

1. The proposed Modification to Ashbrook Would Render the Invention  
Unsatisfactory for its Intended Purpose.

Appellant stated, "*In particular, the proposed modification would prohibit (1) envelopes from being readily grasped and removed, and (2) disposal of the envelope holder in conventional desk drawers.*

First Examiner takes note that is not actually necessary to place the insert in a bin or change it physically to meet the limitations of the claim. Pippin is only necessary to show the capability of the insert to be placed in a bin and sized accordingly as the limitations are functional and the claim does not actually require a bin. Secondly Examiner disagrees that if the insert was modified that it would be unable to be disposed in a conventional desk drawer as argued. Conventional desk drawers vary greatly in size and many are sized to accommodate hanging folders. Examiner contends that even if the modifications were made the device could still fit in at least some portion of conventional desks drawers such as those configured to hold hanging folders. Third Examiner contends that the modification would not prevent the envelopes from being readily grasped as each area for receiving envelopes would still be of a size that would allow such action. Furthermore some envelopes are larger than others and will always be easier to remove than other smaller envelopes.

Examiner further contends that the appellant has taken a narrow view of the actual function of the Ashbrook device. Examiner contends that the function is to hold

flat items in a relatively vertical position so they can be easily removed. Ashbrook even discloses the device "is not restricted to use within a drawer, nor to the holding of envelopes" (p1 lines 64+). Examiner contends that even if modified to actually be placed in a bin and sized accordingly the Ashbrook device will still readily perform its intended function.

2. The Proposed Modification to Ashbrook Would Change the Principle of Operation of the Invention.

Appellant stated, "...*the Examiner proposed using the envelope holder for mail delivery. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the envelope holder of Ashbrook, as well as a change in the basic principle (i.e., holding envelopes for personal or office use) under which the envelope holder was designed to operate.*"

Examiner disagrees with the above statement and maintains that no actual physical modification is necessary to meet the claimed limitations but rather that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly. Therefore it is not necessary to physically modify the Ashbrook device to meet claim limitations drawn to a mail bin insert without the bin.

Furthermore examiner contends that even if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Ashbrook device. The Ashbrook device would still be used to hold flat articles, in particular envelopes, in a substantially upright position such that they can easily be

grasped and removed. Furthermore as set forth previously examiner contends that the device would still readily fit in many conventional desk drawers. The fact that the device is being used to facilitate mail delivery does not change that it is still holding envelopes in the manner in which is it was designed. Mail delivery and sorting is a further application of the functionality and intended envelope holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still performing its originally designed function of holding envelopes in a vertical position where they can be easily grasped and removed. Further Examiner contends that these features would make the device especially useful and beneficial for use in mail sorting and delivery.

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Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly. No physical modification is needed to meet the claimed limitations directed to a mail bin insert.

Appellant stated, "*Accordingly, one would not have been motivated to combine Ashbrook with Pippin, because Pippin teaches away from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.*"

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket

only holds mail for a single delivery point. This is not the case with Ashbrook or the claimed invention. Both Ashbrook and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Ashbrook or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

iv. Independent Claim 20

1. The proposed Modification to Ashbrook Would Render the Invention Unsatisfactory for its Intended Purpose.

Appellant stated, "...would thus prohibit (1) envelopes from being readily grasped and removed, and (2) disposal of the envelope holder in conventional desk drawers.

First Examiner takes note that is not actually necessary to place the insert in a bin to meet the limitations of the claim. Pippin is only necessary to show the capability of the insert to be placed in a bin and sized accordingly as the limitations are functional and the claim does not actually require a bin. Secondly Examiner disagrees that if the insert was modified that it would be unable to be disposed in a conventional desk drawer as argued. Conventional desk drawers vary greatly in size and many are sized to accommodate hanging folders. Examiner contends that even if the modifications were made the device could still fit in at least some portion of conventional desks drawers such as those configured to hold hanging folders. Third Examiner contends that the modification would not prevent the envelopes from being readily grasped as each area for receiving envelopes would still be of a size that would allow such action. Furthermore some envelopes are larger than others and will always be easier to remove than other smaller envelopes.

Examiner further contends that the appellant has taken a narrow view of the actual function of the Ashbrook device. Examiner contends that the function is to hold flat items in a relatively vertical position so they can be easily removed. Ashbrook even discloses the device "is not restricted to use within a drawer, nor to the holding of envelopes" (p1 lines 64+). Examiner contends that even if modified to actually be

placed in a bin and sized accordingly the Ashbrook device will still readily perform its intended function.

2. The Proposed Modification to Ashbrook Would Change the Principle of Operation of the Invention.

Appellant stated, “*...the Examiner proposed using the envelope holder for mail delivery. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the envelope holder of Ashbrook, as well as a change in the basic principle (i.e., holding envelopes for personal or office use) under which the envelope holder was designed to operate.*”

Examiner disagrees with the above statement and maintains that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly. Therefore it is not necessary to physically modify the Ashbrook device to meet claim limitations drawn to a mail bin insert without the bin.

Furthermore examiner contends that even if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Ashbrook device. The Ashbrook device would still be used to hold flat articles, in particular envelopes, in a substantially upright position such that they can easily be grasped and removed. Furthermore as set forth previously examiner contends that the device would still readily fit in many conventional desk drawers. The fact that the device is being used to facilitate mail delivery does not change that it is still holding envelopes in the manner in which it was designed. Mail delivery and sorting is a further

application of the functionality and intended envelope holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still performing its originally designed function of holding envelopes in a vertical position where they can be easily grasped and removed. Further Examiner contends that these features would make the device especially useful and beneficial for use in mail sorting and delivery.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly.

Appellant stated, *“Accordingly, one would not have been motivated to combine Ashbrook with Pippin, because Pippin teaches away from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.”*

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Ashbrook or the claimed invention. Both Ashbrook and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where

items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Ashbrook or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. Neither reference teaches the recited, "flat sheet" including "predefined fold lines"

Examiner contends that Ashbrook discloses, "a single metal sheet which is bent to provide a plurality of transverse, open ended channel shaped pockets." (p1 lines 24+). Examiner contends that such construction constitutes a flat sheet including predefined fold lines as one must determine where they are going to fold before doing so in order to end up with the final Ashbrook device. The folds are clearly visible in figure 3.

5. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

**B. Claims 1-13 and 15-27 are not Patentable over Lambert in view of Pippin**

The rejection of claims 1-13 and 15-27 as obvious over Lambert in view of Pippin is proper and should be affirmed.

i. Independent claim 1

Appellant stated, "*Applicants disagree that there is any acceptable suggestion or motivation in the prior art to modify the teachings of Lambert with the teachings of Pippin to achieve the claimed invention.*"

Examiner contends that the claim does not positively recite the mail bin in a way that actually requires the mail bin and therefore without the mail bin the size of features relative to the mail bin is functional. The Lambert device is capable of being placed in a bin that would have a size meeting the relative limitations set forth in the claim. The combination with Pippin shows that inserts, such as that disclosed by Lambert, can be and are readily placed in mail bins and sized accordingly to the bins. Therefore Pippin is only necessary to show that an insert can be placed in a bin and sized according to the bin. The claim is drawn to a mail bin insert rather than the combination of mail bin insert and a mail bin in which the insert is disposed therefore Pippin is only needed to show the ability of an insert to be placed in a bin and sized accordingly not the actual mail bin or sizing of the insert. Beyond showing the mere capability of the placement in the bin and appropriate sizing relative thereto Examiner further contends that one of ordinary skill in the art would be motivated to combine the teachings for the purposes of

maintaining sequence order and facilitating delivery (c6 lines 13+) and allowing storage and use of the insert with flats tubs or letter trays (c6 lines 10+).

1. The proposed Modification to Lambert Would Render the Invention Unsatisfactory for its Intended Purpose.

Appellant stated, "*Modifying the record keeping tray 10 of Lambert in the manner suggested would result in an unwieldy organizer, completely unsuited for the purpose of organizing canceled checks. Quite the opposite of being a desirable modification, the suggested modification would destroy the objectives of Lambert in achieving a "convenient, compact" record keeping tray. In addition, the dividers could no longer occupy the box assembly 12, because they would exceed its dimensions. It is entirely unclear how the record keeping tray 10 could continue to serve its purpose of organizing canceled checks.*"

First Examiner takes note that is not actually necessary to place the insert in a bin or change it physically to meet the limitations of the claim. Pippin is only necessary to show the capability of the insert to be placed in a bin and sized accordingly as the limitations are functional and the claim does not actually require a bin. Secondly Examiner disagrees that if modified the Lambert device would be unable to organize canceled checks. The various receiving areas would still readily accommodate canceled checks and facilitate their orderly separation into category subdivisions. Furthermore Lambert anticipates use with bank statements (c5 lines 55+) which examiner contends would be very similar in size to envelopes especially full size

envelopes that do not require the contents to be folded. Therefore in this case the dividers would be sized larger than those used for accommodating canceled checks.

Examiner further contends that the appellant has taken a narrow view of the actual function of the Lambert device. Examiner contends that the function is to hold flat items in a relatively vertical position so they can be easily removed. Examiner contends that even if modified to actually be placed in a bin and sized accordingly the Lambert device will still readily perform its intended function of holding canceled checks and bank statements. Examiner further contends that the insert 33 in Lambert is very similar to that claimed by applicant and that usage in a container other than the box disclosed by Lambert would not prevent the device from performing its intended purpose.

2. The Proposed Modification to Lambert Would Change the Principle of Operation of the Invention.

Appellant stated, "*Thus, the Examiner suggests modifying Lambert so that the dividers 13 are used (in connection with the flats tub of Pippin) for mail delivery, a purpose completely unrelated to - and incompatible with – the intended purpose of the primary reference.*" And "*the modification suggested by the Examiner requires the type of "substantial reconstruction and redesign" that court in In re Ratti deemed an improper modification of the primary reference. The proposed modification entirely changes both the structure and purpose of the invention of Lambert. In particular, the proposed modification would result in an record keeping tray that would no longer resemble the*

*inventive structure envisioned in Lambert, and have none of the functionality originally intended."*

Examiner disagrees with all of the above statements and maintains that no actual physical modification is necessary to meet the claimed limitations but rather that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly. Therefore it is not necessary to physically modify the Lambert device to meet claim limitations drawn to a mail bin insert without the bin.

Furthermore examiner contends that even if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Lambert device. The Lambert device would still be capable of holding canceled checks and bank statements. The fact that the device is being used to facilitate mail delivery does not prevent it from holding other items. Mail delivery and sorting is a further application of the functionality and intended holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still being readily capable of performing its originally designed function of holding canceled checks and bank statements. Simply put the modification does not prevent the device from performing its originally intended purpose.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly. No physical modification is needed to meet the claimed limitations directed to a mail bin insert.

Appellant stated, "*Accordingly, one would not have been motivated to combine Lambert with Pippin, because Pippin teaches away from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.*"

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Lambert or the claimed invention. Both Lambert and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Lambert or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much

as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

ii. Independent claim 9

1. The proposed Modification to Lambert Would Render the Invention Unsatisfactory for its Intended Purpose.

Appellant stated, *"First, as discussed above, the record keeping tray 10 is constructed to be a "convenient, compact" record keeping tray. Modifying Lambert in the manner proposed would thwart these objectives, resulting in an unwieldy and impractical arrangement. Moreover, by increasing the height of the spaced dividers 13, the dividers could no longer occupy the box assembly 12, because they would exceed its dimensions."*

Examiner contends that even if modified and placed in a bin the device would still be capable of use in organizing canceled checks and bank statements. Examiner contends that that increasing the size of the device would potentially allow more items to be stored and increasing the height of the divider would ensure better segregation between the regions. Examiner contends that convenient and compact are broad terms and really the appropriate size is dependant upon the desired holding capacity or what an individual user may actually decide to put in the device. Furthermore while the insert

may exceed the dimensions of the box this is not important as it would be used in a bin which would provide the function of the box.

2. The Proposed Modification to Lambert Would Change the Principle of Operation of the Invention.

Appellant stated, *“the Examiner proposed using the dividers 13 (in connection with the flats tub 50 of Pippin) for mail delivery. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the record keeping tray of Lambert, as well as a change in the basic principle (i.e., organizing canceled checks) under which the record keeping tray was designed to operate.”*

Examiner disagrees with all of the above statements and maintains that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly.

Furthermore examiner contends that if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Lambert device. The Lambert device would still be capable of holding canceled checks and bank statements. The fact that the device is being used to facilitate mail delivery does not prevent it from holding other items. Mail delivery and sorting is a further application of the functionality and intended holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still being readily capable of performing its originally designed

function of holding canceled checks and bank statements. Simply put the modification does not prevent the device from performing its originally intended purpose.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly.

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Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Lambert or the claimed invention. Both Lambert and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Lambert or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

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Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

iii. Independent Claim 19

1. The proposed Modification to Lambert Would Render the Invention Unsatisfactory for its Intended Purpose.

Appellant stated, "*First, as discussed above, the record keeping tray 10 is constructed to be a "convenient, compact" record keeping tray. Modifying Lambert in the manner proposed would thwart these objectives, resulting in an unwieldy and impractical arrangement. Moreover, by increasing the height of the spaced dividers 13, the dividers could no longer occupy the box assembly 12, because they would exceed its dimensions.*"

Examiner contends that even if modified and placed in a bin the device would still be capable of use in organizing canceled checks and bank statements. Examiner contends that that increasing the size of the device would potentially allow more items

to be stored and increasing the height of the divider would ensure better segregation between the regions. Examiner contends that convenient and compact are broad terms and really the appropriate size is dependant upon the desired holding capacity or what an individual user may actually decide to put in the device. Furthermore while the insert may exceed the dimensions of the box this is not important as it would be used in a bin which would provide the function of the box.

2. The Proposed Modification to Lambert Would Change the Principle of Operation of the Invention.

Appellant stated, *"the Examiner proposed using the dividers 13 (in connection with the flats tub 50 of Pippin) for mail delivery. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the record keeping tray of Lambert, as well as a change in the basic principle (i.e., organizing canceled checks) under which the record keeping tray was designed to operate."*

Examiner disagrees with all of the above statements and maintains that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly.

Furthermore examiner contends that if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Lambert device. The Lambert device would still be capable of holding canceled checks and bank statements. The fact that the device is being used to facilitate mail delivery does not prevent it from holding other items. Mail delivery and sorting is a further

application of the functionality and intended holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still being readily capable of performing its originally designed function of holding canceled checks and bank statements. Simply put the modification does not prevent the device from performing its originally intended purpose.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly. No physical modification is needed to meet the claimed limitations directed to a mail bin insert.

Appellant stated, *“Accordingly, one would not have been motivated to combine Lambert with Pippin, because Pippin teaches away from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.”*

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Lambert or the claimed invention. Both Lambert and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where

items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Lambert or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

iv. Independent claim 20

1. The proposed Modification to Lambert Would Render the Invention Unsatisfactory for its Intended Purpose.

Appellant stated, "*First, as discussed above, the record keeping tray 10 is constructed to be a "convenient, compact" record keeping tray. Modifying Lambert in the manner proposed would thwart these objectives, resulting in an unwieldy and impractical arrangement. Moreover, by increasing the height of the spaced dividers 13,*

*the dividers could no longer occupy the box assembly 12, because they would exceed its dimensions."*

Examiner contends that even if modified and placed in a bin the device would still be capable of use in organizing canceled checks and bank statements. Examiner contends that that increasing the size of the device would potentially allow more items to be stored and increasing the height of the divider would ensure better segregation between the regions. Examiner contends that convenient and compact are broad terms and really the appropriate size is dependant upon the desired holding capacity or what an individual user may actually decide to put in the device. Furthermore while the insert may exceed the dimensions of the box this is not important as it would be used in a bin which would provide the function of the box.

2. The Proposed Modification to Lambert Would Change the Principle of Operation of the Invention.

Appellant stated, "*the Examiner proposed using the dividers 13 (in connection with the flats tub 50 of Pippin) for mail delivery. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the record keeping tray of Lambert, as well as a change in the basic principle (i.e., organizing canceled checks) under which the record keeping tray was designed to operate.*"

Examiner disagrees with all of the above statements and maintains that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly.

Furthermore examiner contends that if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Lambert device. The Lambert device would still be capable of holding canceled checks and bank statements. The fact that the device is being used to facilitate mail delivery does not prevent it from holding other items. Mail delivery and sorting is a further application of the functionality and intended holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still being readily capable of performing its originally designed function of holding canceled checks and bank statements. Simply put the modification does not prevent the device from performing its originally intended purpose.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly.

Appellant stated, "*Accordingly, one would not have been motivated to combine Lambert with Pippin, because Pippin teaches away from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.*"

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Lambert or the

claimed invention. Both Lambert and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Lambert or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

C. Claims 1-13 and 15-27 are not patentable over Henig in view of

Pippin

The rejection of claims 1-13 and 15-27 as obvious over Henig in view of Pippin is proper and should be affirmed.

i. Independent claim 1

Appellant stated, *"Applicants disagree that there is any acceptable suggestion or motivation in the prior art to modify the teachings of Henig with the teachings of Pippin to achieve the claimed invention."*

Examiner contends that the claim does not positively recite the mail bin in a way that actually requires the mail bin and therefore without the mail bin the size of features relative to the mail bin is functional. The Henig device is capable of being placed in a bin that would have a size meeting the relative limitations set forth in the claim. The combination with Pippin shows that inserts, such as that disclosed by Henig, can be and are readily placed in mail bins and sized accordingly to the bins. Therefore Pippin is only necessary to show that an insert can be placed in a bin and sized according to the bin. The claim is drawn to a mail bin insert rather than the combination of mail bin insert and a mail bin in which the insert is disposed therefore Pippin is only needed to show the ability of an insert to be placed in a bin and sized accordingly not the actual mail bin or sizing of the insert. Beyond showing the mere capability of the placement in the bin and appropriate sizing relative thereto Examiner further contends that one of ordinary skill in the art would be motivated to combine the teachings for the purposes of maintaining sequence order and facilitating delivery (c6 lines 13+) and allowing storage and use of the insert with flats tubs or letter trays (c6 lines 10+).

1. The proposed Modification to Henig Would Render the Invention Unsatisfactory for its Intended Purpose.

Appellant stated, "*Modifying the receptacle 1 of Henig in the manner suggested would entirely subvert the purpose of the receptacle, which is to arrange letters of a group in a consistent orientation so that they may be removed as a group or stack ready for banding or tying. If the notches 7 of the corrugated bottom wall 2 were somehow resized to have a height approximating that of the flats tub 50 of Pippin, rather than the notches 7 receiving only the lower edge of letters as designed, the notches would far exceed (i.e., by more than double) the height of the letters. The receptacle 1 could not longer work as intended, such that letters pivot backwards and rest on end wall 3. Significantly, letters of a group could no longer be removed as a group or stack.*"

First Examiner takes note that is not actually necessary to place the insert in a bin or change it physically to meet the limitations of the claim. Pippin is only necessary to show the capability of the insert to be placed in a bin and sized accordingly as the limitations are functional and the claim does not actually require a bin. Secondly Examiner disagrees that if modified the Henig device would be unable to arrange letters of a group in a consistent orientation. The various receiving areas would still readily accommodate letters.

Examiner further contends that the appellant has taken a narrow view of the actual function of the Henig device. Examiner contends that the function is to hold flat items in a relatively vertical position so they can be easily removed. Specifically Henig states "serves both to orient flat articles in a predetermined fashion as they are dropped therein and thereafter to maintain the articles in their oriented relation" (c1 lines 46+).

Examiner contends that even if modified to actually be placed in a bin and sized accordingly the Henig device will still readily perform its intended function of orienting articles and maintaining them in their oriented relation.

Examiner contends that even if the corrugated bottom was resized the Henig device would readily perform its intended purpose and the items would simply contact the adjacent corrugated section rather than the previous item or the back wall.

2. The Proposed Modification to Henig Would Change the Principle of Operation of the Invention.

Appellant stated, "*Thus, the Examiner suggests modifying Henig so that the receptacle 1 is disposed within the flats tub of Pippin and used for mail delivery. This purpose is completely incompatible with the intended purpose of the primary reference, which is to arrange letters of a single address.*" and "*The proposed modification entirely changes both the structure and purpose of the invention of Henig.*"

Examiner disagrees with the above statements and maintains that no actual physical modification is necessary to meet the claimed limitations but rather that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly. Therefore it is not necessary to physically modify the Henig device to meet claim limitations drawn to a mail bin insert without the bin.

Furthermore examiner contends that even if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the

Henig device. The Henig device would still be capable of orienting articles and maintaining them in their oriented relation. The fact that the device is being used to facilitate mail delivery does not prevent it from orienting articles and maintaining them in their oriented relation. In fact these functions are actually necessary and beneficial to the proposed usage. Mail delivery and sorting is a further application of the functionality and intended holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still being readily capable of performing its originally designed function of orienting articles and maintaining them in their oriented relation. Simply put the modification does not prevent the device from performing its originally intended purpose.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly. No physical modification is needed to meet the claimed limitations directed to a mail bin insert.

Appellant stated, *“Accordingly, one would not have been motivated to combine Henig with Pippin, because Pippin teaches away from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.”*

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket

only holds mail for a single delivery point. This is not the case with Henig or the claimed invention. Both Henig and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Henig or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

ii. Independent Claim 9

1. The proposed Modification to Henig Would Render the Invention  
Unsatisfactory for its Intended Purpose

Appellant stated, "*The modification to Henig proposed in connection with claim 9 would render the invention of Henig unsatisfactory for its intended purpose. As explained in connection with claim 1, modifying the receptacle 1 of Henig in the manner suggested would entirely subvert the purpose of the receptacle, which is to arrange letters of a group so that they may be removed as a group or stack ready for banding or tying.*"

First Examiner takes note that is not actually necessary to place the insert in a bin to meet the limitations of the claim. Pippin is only necessary to show the capability of the insert to be placed in a bin and sized accordingly as the limitations are functional and the claim does not actually require a bin. Secondly Examiner disagrees that if modified the Henig device would be unable to arrange letters of a group in a consistent orientation. The various receiving areas would still readily accommodate letters.

Examiner further contends that the appellant has taken a narrow view of the actual function of the Henig device. Examiner contends that the function is to hold flat items in a relatively vertical position so they can be easily removed. Specifically Henig states "serves both to orient flat articles in a predetermined fashion as they are dropped therein and thereafter to maintain the articles in their oriented relation" (c1 lines 46+). Examiner contends that even if modified to actually be placed in a bin and sized accordingly the Henig device will still readily perform its intended function of orienting articles and maintaining them in their oriented relation.

Examiner contends that even if the corrugated bottom was resized the Henig device would readily perform its intended purpose and the items would simply contact the adjacent corrugated section rather than the previous item or the back wall.

2. The Proposed Modification to Henig Would Change the Principle of Operation of the Invention.

Appellant stated, *“the Examiner proposed using the receptacle for mail delivery. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the receptacle of Henig, as well as a change in the basic principle (i.e., arranging letters of a single address) under which the receptacle was designed to operate.”*

Examiner disagrees with the above statements and maintains that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly.

Furthermore examiner contends that if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Henig device. The Henig device would still be capable of orienting articles and maintaining them in their oriented relation. The fact that the device is being used to facilitate mail delivery does not prevent it from orienting articles and maintaining them in their oriented relation. In fact these functions are actually necessary and beneficial to the proposed usage. Mail delivery and sorting is a further application of the functionality and intended holding capabilities of the device rather than a new and different purpose. Examiner

contends that the device can be used for mail delivery and sorting while still being readily capable of performing its originally designed function of orienting articles and maintaining them in their oriented relation. Simply put the modification does not prevent the device from performing its originally intended purpose.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly.

Appellant stated, "*Accordingly, one would not have been motivated to combine Henig with Pippin, because Pippin teaches away from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.*"

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Henig or the claimed invention. Both Henig and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Henig or the claimed invention and therefore rigid or pliable dividers can

solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

iii. Independent claim 19

1. The proposed Modification to Henig Would Render the Invention Unsatisfactory for its Intended Purpose.

Appellant stated, "*Modifying the receptacle 1 of Henig in the manner suggested would entirely subvert the purpose of the receptacle, which is to arrange letters of a group in a consistent orientation so that they may be removed as a group or stack ready for banding or tying. If the notches 7 of the corrugated bottom wall 2 were somehow resized to have a height approximating that of the flats tub 50 of Pippin, rather than the notches 7 receiving only the lower edge of letters as designed, the notches would far exceed (i.e., by more than double) the height of the letters. The receptacle 1 could not*

*longer work as intended, such that letters pivot backwards and rest on end wall 3.*

*Significantly, letters of a group could no longer be removed as a group or stack."*

First Examiner takes note that is not actually necessary to place the insert in a bin or change it physically to meet the limitations of the claim. Pippin is only necessary to show the capability of the insert to be placed in a bin and sized accordingly as the limitations are functional and the claim does not actually require a bin. Secondly Examiner disagrees that if modified the Henig device would be unable to arrange letters of a group in a consistent orientation. The various receiving areas would still readily accommodate letters.

Examiner further contends that the appellant has taken a narrow view of the actual function of the Henig device. Examiner contends that the function is to hold flat items in a relatively vertical position so they can be easily removed. Specifically Henig states "serves both to orient flat articles in a predetermined fashion as they are dropped therein and thereafter to maintain the articles in their oriented relation" (c1 lines 46+). Examiner contends that even if modified to actually be placed in a bin and sized accordingly the Henig device will still readily perform its intended function of orienting articles and maintaining them in their oriented relation.

Examiner contends that even if the corrugated bottom was resized the Henig device would readily perform its intended purpose and the items would simply contact the adjacent corrugated section rather than the previous item or the back wall.

2. The Proposed Modification to Henig Would Change the Principle of Operation of the Invention.

Appellant stated, *"the Examiner proposed using the receptacle for mail delivery. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the receptacle of Henig, as well as a change in the basic principle (i.e., arranging letters of a single address) under which the receptacle was designed to operate."*

Examiner disagrees with the above statements and maintains that no actual physical modification is necessary to meet the claimed limitations but rather that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly. Therefore it is not necessary to physically modify the Henig device to meet claim limitations drawn to a mail bin insert without the bin.

Furthermore examiner contends that even if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Henig device. The Henig device would still be capable of orienting articles and maintaining them in their oriented relation. The fact that the device is being used to facilitate mail delivery does not prevent it from orienting articles and maintaining them in their oriented relation. In fact these functions are actually necessary and beneficial to the proposed usage. Mail delivery and sorting is a further application of the functionality and intended holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still

being readily capable of performing its originally designed function of orienting articles and maintaining them in their oriented relation. Simply put the modification does not prevent the device from performing its originally intended purpose.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly. No physical modification is needed to meet the claimed limitations directed to a mail bin insert.

Appellant stated, "*Accordingly, one would not have been motivated to combine Henig with Pippin, because Pippin teaches away from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.*"

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Henig or the claimed invention. Both Henig and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Henig or the claimed invention and therefore rigid or pliable dividers can

solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

iv. Independent Claim 20

1. The proposed Modification to Henig Would Render the Invention Unsatisfactory for its Intended Purpose

Appellant stated, "*The modification to Henig proposed in connection with claim 9 would render the invention of Henig unsatisfactory for its intended purpose. As explained in connection with claim 1, modifying the receptacle 1 of Henig in the manner suggested would entirely subvert the purpose of the receptacle, which is to arrange letters of a group so that they may be removed as a group or stack ready for banding or tying.*"

First Examiner takes note that is not actually necessary to place the insert in a bin to meet the limitations of the claim. Pippin is only necessary to show the capability of the insert to be placed in a bin and sized accordingly as the limitations are functional and the claim does not actually require a bin. Secondly Examiner disagrees that if modified the Henig device would be unable to arrange letters of a group in a consistent orientation. The various receiving areas would still readily accommodate letters.

Examiner further contends that the appellant has taken a narrow view of the actual function of the Henig device. Examiner contends that the function is to hold flat items in a relatively vertical position so they can be easily removed. Specifically Henig states "serves both to orient flat articles in a predetermined fashion as they are dropped therein and thereafter to maintain the articles in their oriented relation" (c1 lines 46+). Examiner contends that even if modified to actually be placed in a bin and sized accordingly the Henig device will still readily perform its intended function of orienting articles and maintaining them in their oriented relation.

Examiner contends that even if the corrugated bottom was resized the Henig device would readily perform its intended purpose and the items would simply contact the adjacent corrugated section rather than the previous item or the back wall.

## 2. The Proposed Modification to Henig Would Change the Principle of Operation of the Invention.

Appellant stated, *"the Examiner proposed using the receptacle for mail delivery. Accordingly, the suggested modification would require a substantial*

*reconstruction and redesign of the receptacle of Henig, as well as a change in the basic principle (i.e., arranging letters of a single address) under which the receptacle was designed to operate."*

Examiner disagrees with the above statements and maintains that Pippin is only necessary to show the capability of the placing the insert in a bin and sizing it accordingly.

Furthermore examiner contends that if the modifications are made, it still would not change the principle of operation nor substantially change the structure of the Henig device. The Henig device would still be capable of orienting articles and maintaining them in their oriented relation. The fact that the device is being used to facilitate mail delivery does not prevent it from orienting articles and maintaining them in their oriented relation. In fact these functions are actually necessary and beneficial to the proposed usage. Mail delivery and sorting is a further application of the functionality and intended holding capabilities of the device rather than a new and different purpose. Examiner contends that the device can be used for mail delivery and sorting while still being readily capable of performing its originally designed function of orienting articles and maintaining them in their oriented relation. Simply put the modification does not prevent the device from performing its originally intended purpose.

3. Pippin clearly teaches away from the modifications proposed by the Examiner.

Examiner reiterates that Pippin is only necessary to show that the insert can be disposed in a mail bin and sized accordingly.

Appellant stated, "*Accordingly, one would not have been motivated to combine Henig with Pippin, because Pippin teaches away from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.*"

Examiner contends that Pippin does not teach away from the combination. In Pippin the dividers whether rigid or pliable are intended to separate mail so each pocket only holds mail for a single delivery point. This is not the case with Henig or the claimed invention. Both Henig and claimed invention seek to subdivide an area into multiple smaller areas that can each receive some number of items. Examiner contends that with this purpose in mind both rigid and pliable dividers can readily perform the task. The downside of rigid dividers is only apparent in situations where items of varying numbers, destined for a single delivery point, are to be placed in a single area. This is not the case in Henig or the claimed invention and therefore rigid or pliable dividers can solve the problem at hand equally well, which is segmenting a larger area into multiple smaller regions to hold envelopes in an upright position.

4. Neither reference teaches the recited "flat sheet" including "predefined fold lines."

Appellant stated, "*The Office Action cites col. 7, lines 10+ of Henig as allegedly disclosing this feature. However, Henig is completely respect with respect to any 'flat sheet' or "predefined fold lines."*"

Examiner contends that Henig discloses, "the receptacle of FIGS 1-7 can be constructed with bottom wall 2a, trailing end wall 3a and front end wall 4a formed of a single piece of single face corrugated box board, with corrugations upwardly exposed as shown, the corrugations then defining the notches 7a." (c7 lines 14+) Examiner contends that such construction constitutes a flat sheet including predefined fold lines as one must determine where they are going to fold before doing so in order to end up with the final Henig device. The folds are clearly visible in figures 2 and 2a.

5. No desirability of making the proposed modification is apparent.

Examiner disagrees and contends that there is desirability in making the modification and reiterates that no physical modification is actually necessary so much as the capability of the insert to be placed in a bin and sized accordingly. Examiner contends that making the physical modification, although unnecessary to meet the claimed limitations, would be desirable in that it would facilitate delivery and maintaining sequence order and allow the use of the insert with standard mail flats tubs and mail bins as used by the USPS.

**Conclusion**

The rejections of claims 1-13 and 15-27 are proper and should be affirmed.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Mark Hageman



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Conferees:

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Mark Hageman